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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,962	04/07/2000	James Shanahan	D/99458	2107

7590

09/22/2004

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/543,962

Applicant(s)

SHANAHAN ET AL.

Examiner

Maikhanh Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 05/25/2004 to the original application filed 04/07/2000.
2. Claims 1-37 are currently pending in this application. Claims 1, 19, and 28 have been amended. Claims 1, 19, and 28 are independent claims.

Claim Objections

3. Claim 3, 19, and 21 are objected to because of the following informalities:
 - “the results from the selected document service **includes** a new document service” (claim 3, lines 1-2 and claim 21, line 1-2) probably read “the results from the selected document service **include** a new document service”; and
 - “user invention” (claim 19, line 7) probably read “user intervention”.Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following phrases lack antecedent basis:

- “the set” (claim 1, line 7; claim 19, line 6; and claim 28, line 7); and

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- “the selected document service” (claim 1, lines 8-9; claim 19, lines 9-10; claim 27, line 7)

Dependent claims 2-18, 20-27, and 29-37 are rejected for fully incorporating the deficiencies of their base claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle (U.S. 6,510,432 – filed 03/2000).

As to independent claim 19, Doyle teaches a method for acquiring information pertaining to a document including information (*e.g., searching the plurality of web servers so as to locate information associated with the at least one topic to be searched and retrieving the located information from at least one of the plurality of web servers; col.1, lines 41-52*), comprising: associating a set of document service requests with the document, wherein a document service comprises a process for using a portion of the information as starting point to obtain other information from a service provider pertaining to the information (*e.g., retrieving a document ... analyzing the document contents to determined if any additional information on the specified topic is identified in the document ... include identity hyper-links in the retrieved document; col.8, lines 2-7*);

- selecting a document service request from the set (*e.g., identifying information accessible through one of the plurality of web servers associated with the at least one topic and retrieving the identified information; col.1, line 53-col.2, line 3*);
- initiating and managing communication with a service provider to satisfy the selected document service (*e.g., the search results are selected by the user ... The obtained search results are then provided to the user ... providing a result web page to a web browser of the user; col.9, lines 32-38*); and
- integrating any results from the selected document service into the document (*e.g., the additional information is then retrieved and archived ... the archived additional information is associated with the at least one topic; col.2, lines 8-14*).

While Doyle teaches autonomously activating and managing to the document service requests (*e.g., the search and archive agent autonomously once the user has defined a topic for search; col.9, lines 46-48*), Doyle does not explicitly teach “without user invention.”

While Doyle teaches autonomously activating and managing to the document service requests (*e.g., the search and archive agent autonomously once the user has defined a topic for search; col.9, lines 46-48*), Doyle does not explicitly teach “without user intervention.”

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have applied Doyle’s teaching to include “*without user intervention*” because it would have provided the capability for performing the search and archive operations while the user’s data processing system is disconnected from the network.

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The fact that Doyle's teaching "*the user need not be 'connected' to the search and archive agent; col.9, lines 46-57*" and purpose of "the user need not be connected" in Doyle suggests without user intervention.

As to dependent claim 20, Doyle teaches the set of document service requests is selected from a group of pre-packaged document service requests (*col.1, line 41-col.2, line 26*).

As to dependent claim 21, Doyle teaches the results from the selected document service includes a new document service request associated with the document (*col.1, line 41-col.2, line 26*).

As to dependent claim 22, Doyle teaches the document services are satisfied by a third party service provider via an Internet protocol (*col.4, lines 28-39 and Fig.1*).

As to dependent claim 23, Doyle teaches the scheduler updates the set of document service requests on a predetermined schedule (*col.7, lines 50-60*).

As to dependent claim 24, Doyle teaches the scheduler re-initiates selected document service request on a periodic basis (*e.g., such gathering is provided by an automated process where searches on the web are periodically carried out to locate information on a user specified topic and that information retrieved and stored in a database so that the content is accessible independent of the status of the content on the web; col.4, lines 14-23*).

As to dependent claim 25, Doyle teaches the periodic basis is determined by the selected document service request (*e.g., the periodicity defines how often the search and archive agent will search the data source ... the periodicity may be hourly ...the topic is*

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currently event, then the periodicity may be daily, weekly or even monthly; col.7, lines 50-60).

As to dependent claim 26, Doyle teaches the set of document service s follow a predetermined sequence of calls to service providers for extracting information from other documents, databases and data stores, and for searching, for other information responsive to any extracted information from the other documents, databases and data stores (*col.4, lines 14-23 and col.7, line 50-col.8, line 41*).

As to dependent claim 27, Doyle teaches the pre-determined sequence of calls to service providers are satisfiable asynchronously (*col.8, lines 1-22*).

As to independent claim 1, it is directed to a system for performing the method of claim 19, and is similarly rejected under the same rationale. Additionally, claim 1 further recites “a scheduler”.

Doyle teaches a scheduler (e.g., *the periodicity defines how often the search and archive agent will search the data source ... the periodicity may be hourly ...the topic is currently event, then the periodicity may be daily, weekly or even monthly; col.7, lines 50-60*).

As to dependent claims 2-7, they include the same limitations as in claims 20-25, and are similarly rejected under the same rationale.

As to dependent claim 8, Doyle teaches the meta-document, the scheduler and the service providers reside at the same location (*col.1, line 41- col.2, line 3 and col. 9, lines 50-60*).

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As to dependent claim 9, Doyle teaches the meta-document, the scheduler and the service providers reside at different locations (*col. 4, lines 40-62 and col. 14, lines 24-31*).

As to dependent claims 10-11, they include the same limitations as in claims 26-27, and are similarly rejected under the same rationale.

As to dependent claim 12, Doyle teaches the document and the set of document service requests are user-selectable (*col. 9, lines 32-38*).

As to dependent claim 13, Doyle teaches in addition to the scheduler (e.g., *the periodicity defines how often the search and archive agent will search the data source ... the periodicity may be hourly ... the topic is currently event, then the periodicity may be daily, weekly or even monthly; col. 7, lines 50-60*), a user may select a document service request from the set (e.g., *identifying information accessible through one of the plurality of web servers associated with the at least one topic and retrieving the identified information; col. 1, line 53-col. 2, line 3*) and initiate and manage communication with a service provider to satisfy the selected document service (e.g., *the search results are selected by the user ... The obtained search results are then provided to the user ... providing a result web page to a web browser of the user; col. 9, lines 32-38*).

As to dependent claim 14, Doyle teaches a list of document service requests from which the set of document service requests may be selected by a user (*col. 8, lines 1-22 and col. 9, lines 21-38*).

As to dependent claim 15, Doyle teaches the service provider is user-selectable (*col. 9, lines 33-38*).

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As to dependent claim 16, Doyle teaches a service provider can register additional document services to the list (*col.2, lines 8-14 and col.8, lines 1-22*).

As to dependent claim 17, Doyle teaches a list of service providers available for satisfying document services (*col.9, lines 18-32*).

As to dependent claim 18, Doyle teaches the set of document service requests associated with the document are associated using metadata (*Abstract and col.10, lines 64-67*).

As to independent claim 28, the rejection of independent claim 19 above is incorporated herein in full.

As to dependent claims 29-34, 35-36 and 37, they include the same limitations as in claims 2-7, 10-11 and 18, and are similarly rejected under the same rationale.

Response to Arguments

6. Applicant's arguments filed on 05/25/2004 have been fully considered, but are deemed to be moot in view of the new grounds of rejection necessitated by Applicant's amendments.

The newly applied prior art (Doyle) meets the claims as amended by Applicant.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reed et al. U.S Patent No. 5,862,325 issued: Jan. 19, 1999

Rogers et al. U.S Patent No. 5,974,441 issued: Oct. 29, 1999

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Cohen et al. U.S Patent No. 6,178,430 issued: Jan. 23, 2001

MacLean et al. U.S Patent No. 6,505,219 issued: Jan. 7, 2003

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. After mid-October, 2004, the examiner can be reached at (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
September 17, 2004


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER